UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/767,721	01/24/2001	Tatsuhiko Ikuta	1614.1115	3663

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EXAMINER
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ART UNIT	PAPER NUMBER
3693	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	09/767,721	IKUTA, TATSUHIKO
	Examiner	Art Unit
	RAJESH KHATTAR	3693

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 October 2008*.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-15* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date *8/18/08*.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Acknowledgements

This office action is in response to Applicant's communication filed on 10/6/2008.

Claims 1-6 and 9 have been amended. As such, claims 1-15 are pending in the

application.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Michel et al, U.S. Patent No. 5,625,690, in view of Lampson et al, U.S. Patent

Application Publication No. 2003/0194094 and further in view of Chiles et al., US Patent

No. 6,167,567. The examiner would like to point out that while Michel may not employ

the same terminology as the present Applicants, Michel does teach the same ideas as

Applicants. Specifically, Michel teaches the idea of certificating although it is couched in

terms of a "software ID number" and "DES key" that is described in Michel at Column 4.

The process of Michel then goes on to teach of a paying-per-use system in which

security is enhanced by reference to a "counter" to determine if continued use of the

software is allowed. This is equivalent to Applicants' licensing system without continual

referral to an accounting server.   What seems to not be expressly taught in Michel are

some of the newer features of software that have been developed and in use since the

publication of Michel. These features are the notions of certificate and license

technologies. However, Lampson discloses features such as certificates and licensing.

Both Michel and Lampson do not disclose user agreed update of the file and a new file

installation independent from said access to the content. Chiles discloses user agreed

updates and a new file installation independent from said access to the content.

Therefore, a combination of these references teaches the present invention as claimed.

With regard to claims 1, 2, 14 and 15, Michel teaches the system and method

comprising:

reporting, via a computer, identification to an accounting server from a terminal device, when
contents to be charged for are accessed in the terminal device, and which is previously
identified in said accounting server; (col. 4, lines 7-13 and 55-59, describing a software
identification number)

confirming propriety of the reported identification in said accounting server, and performing fee
charging; and (col. 4, line 64 – col. 5, line 3, describing confirming identifying information; col. 8,
lines 24-32, describing fee charging)

when the propriety of the registration certification is confirmed, reporting permission of access to
the contents, from said accounting server to said terminal device, and making the contents
accessible in said terminal device, (col. 5, lines 4-29 describing a public/private key system for
accessing contents), wherein

the terminal device, when access is made to the contents, referring to a license file in the
terminal device, and, when the license file is determined to be valid, access to the contents is
continued without accessing the accounting server, and

the terminal device, when the license file is not determined to be valid and a user at the terminal
device agrees to update the license file, accesses the accounting server is carried out,
notification of charging is made to the accounting server and, after the completion of the
charging, access to the contents is continued.

As mentioned above Michel, does not expressly teach certificates and licenses.

However, these aspects of the invention are taught by Lampson (paragraph 93, and

Figures 9,11). As well, Michel teaches the act of checking validity of number of uses of

a software program, at (Michel, col. 8, lines 24-32). Therefore, it would have been

obvious to a person having ordinary skills in the art at the time the invention was made

to modify the disclosure of Michel to include the disclosure of Lampson. The motivation

to combine these two references would be to utilize the pay per use protection

technique for the unauthorized use of the computer software as evidenced by Michel

(Abstract).

Moreover, Michel and Lampson do not disclose user at the terminal device

agrees to update the license file and a new license file received from the accounting

server is installed independent from said access to the contents. Since, Lampson teach

certificates and licenses, Examiner cites Chiles disclosing "user at the terminal device

agrees to update the file and a new file received from the accounting server is installed"

(col. 14, lines 62-col.19, lines 19; also see Fig. 5A-5D). Chiles also discloses a new file

received from the accounting server is installed independent from said access to the

contents (col. 2, lines 42-56). In other words, Chiles discloses monitoring on a periodic

basis (user-initiated or automatic time-scheduled basis) whether the client software

should be updated based on comparison of version numbers of the most recent update

available at that site and installed at the client. If the client software requires new

update, then downloading/installing updated file and changing the version number of

client's software. This interpretation is further supported by Applicant's remarks dated

3/31/2008 regarding having a system to monitor the validity of a license having the

ability to install a new license when the old license is invalid independent of the specific

contents. The automatic update feature of Chiles is consistent with Applicant's remarks

dated 10/6/2008 (page 10) regarding determining its own license validity status and

updating the license file in the terminal device.

Thus a combination of the references teaches:

the terminal device, when the license file is not determined to be valid and a user at the
terminal device agrees to update the license file, accesses the accounting server based
on the registration certification, notification of charging is made to the accounting server
and, after the completion of the charging, access to the contents is continued and a new
license file received from the accounting server is installed independent from said
access to the contents.

Therefore, it would have been obvious to a person having ordinary skills in the art

at the time the invention was made to modify the disclosure of Michel and Lampson to

include the disclosure of Chiles. The motivation for combining these references would

be to allow user-initiated update for the software product to take place as evidenced by

Chiles (col. 14, lines 63-67).

With regard to claims 3, 6 and 10, Michel teaches the method, device, and

recording medium comprising:

determining, via a computer, whether or not a condition for accessing contents is satisfied, when
the contents are accessed; and wherein

enabling access to the contents when the condition for accessing the contents is satisfied, and
enabling access to the contents after performing fee charging when the condition for accessing
the contents is not satisfied,

(col. 8, lines 24-32 fee charging; col. 4, line 64 – col. 5, line 3; col. 5, lines 4-29 describing a
public/private key system for accessing contents)

As mentioned above Michel, does not expressly teach certificates and licenses.

However, these aspects of the invention are taught by Lampson (paragraph 93, and

Figures 9,11). As well, Michel teaches the act of checking validity of number of uses of

a software program, at (Michel, col. 8, lines 24-32). Therefore, it would have been

obvious to a person having ordinary skills in the art at the time the invention was made

to modify the disclosure of Michel to include the disclosure of Lampson. The motivation

to combine these two references would be to utilize the pay per use protection

technique for the unauthorized use of the computer software as evidenced by Michel

(Abstract).

Moreover, Michel and Lampson do not disclose user at the terminal device

agrees to update the license file and a new license file received from the accounting

server is installed independent from said access to the contents. Since, Lampson teach

certificates and licenses, Examiner cites Chiles disclosing "user at the terminal device

agrees to update the file and a new file received from the accounting server is installed"

(col. 14, lines 62-col.19, lines 19; also see Fig. 5A-5D). Chiles also discloses a new file

received from the accounting server is installed independent from said access to the

contents (col. 2, lines 42-56). In other words, Chiles discloses monitoring on a periodic

basis (user-initiated or automatic time-scheduled basis) whether the client software

should be updated based on comparison of version numbers of the most recent update

available at that site and installed at the client. If the client software requires new

update, then downloading/installing updated file and changing the version number of

client's software. This interpretation is further supported by Applicant's remarks dated

3/31/2008 regarding having a system to monitor the validity of a license having the

ability to install a new license when the old license is invalid independent of the specific

contents. The automatic update feature of Chiles is consistent with Applicant's remarks

dated 10/6/2008 (page 10) regarding determining its own license validity status and

updating the license file in the terminal device.

Thus a combination of the references teaches:

at the terminal device, when the license file is not determined to be valid and a user at
the terminal device agrees to update the license file, accesses the accounting server
based on the registration certification, notification of charging is made to the accounting
server and, after the completion of the charging, access to the contents is continued and
a new license file received from the accounting server is installed independent from said
access to the contents.

Therefore, it would have been obvious to a person having ordinary skills in the art

at the time the invention was made to modify the disclosure of Michel and Lampson to

include the disclosure of Chiles. The motivation for combining these references would

be to allow user-initiated update for the software product to take place as evidenced by

Chiles (col. 14, lines 63-67).

With regard to claims 4, 7 and 11, Michel teaches the method, device, and

recording medium comprising:

determining, via a computer, whether or not a condition for accessing contents is
satisfied; reporting fee charging to an accounting server when the condition for
accessing the contents is not satisfied; and updating from said accounting server the
condition for accessing the contents into a condition such that the contents can be
accessed, wherein,

(col. 8, lines 24-32 fee charging; col. 4, line 64 – col. 5, line 3; col. 5, lines 4-29
describing a public/private key system for accessing contents)

As mentioned above Michel, does not expressly teach certificates and licenses.

However, these aspects of the invention are taught by Lampson (paragraph 93, and

Figures 9,11). As well, Michel teaches the act of checking validity of number of uses of

a software program, at (Michel, col. 8, lines 24-32). Therefore, it would have been

obvious to a person having ordinary skills in the art at the time the invention was made

to modify the disclosure of Michel to include the disclosure of Lampson. The motivation to combine these two references would be to utilize the pay per use protection technique for the unauthorized use of the computer software as evidenced by Michel (Abstract).

Moreover, Michel and Lampson do not disclose user at the terminal device agrees to update the license file and a new license file received from the accounting server is installed independent from said access to the contents. Since, Lampson teach certificates and licenses, Examiner cites Chiles disclosing "user at the terminal device agrees to update the file and a new file received from the accounting server is installed" (col. 14, lines 62-col.19, lines 19; also see Fig. 5A-5D). Chiles also discloses a new file received from the accounting server is installed independent from said access to the contents (col. 2, lines 42-56). In other words, Chiles discloses monitoring on a periodic basis (user-initiated or automatic time-scheduled basis) whether the client software should be updated based on comparison of version numbers of the most recent update available at that site and installed at the client. If the client software requires new update, then downloading/installing updated file and changing the version number of client's software. This is further supported by Applicant's remarks dated 3/31/2008 regarding having a system to monitor the validity of a license having the ability to install a new license when the old license is invalid independent of the specific contents. The automatic update feature of Chiles is consistent with Applicant's remarks dated 10/6/2008 (page 10) regarding determining its own license validity status and updating the license file in the terminal device.

Thus a combination of the references teaches:

at the terminal device, when the license file is not determined to be valid and a user at the terminal device agrees to update the license file, accesses the accounting server based on the registration certification, notification of charging is made to the accounting server and, after the completion of the charging, access to the contents is continued and a new license file received from the accounting server is installed independent from said access to the contents.

Therefore, it would have been obvious to a person having ordinary skills in the art at the time the invention was made to modify the disclosure of Michel and Lampson to include the disclosure of Chiles. The motivation for combining these references would be to allow user-initiated update for the software product to take place as evidenced by Chiles (col. 14, lines 63-67).

With regard to claims 8 and 12, Michel teaches the device and recording medium wherein:

said determining part, accounting reporting part and updating part are achieved on an operating system of a terminal device. (col. 9-10, claims 3-7)

With regard to claims 5, 9 and 13, Michel teaches the method, device, and recording medium comprising:

receiving, via a computer, information previously issued for registration of a terminal device, and determining whether or not the information is valid;
(col. 4, lines 7-13 and 55-59, describing a software identification number)

transmitting the determination result to said terminal device, generating information indicating that a condition for accessing contents is satisfied when the determination result is that the certificate is valid, and transmitting the generated information to said terminal device; and (col. 4, line 64 – col. 5, line 3; col. 5, lines 4-29 describing a public/private key system for accessing contents)

As mentioned above Michel, does not expressly teach certificates and licenses.

However, these aspects of the invention are taught by Lampson (paragraph 93, and Figures 9,11). As well, Michel teaches the act of checking validity of number of uses of a software program, at (Michel, col. 8, lines 24-32). Therefore, it would have been

obvious to a person having ordinary skills in the art at the time the invention was made

to modify the disclosure of Michel to include the disclosure of Lampson. The motivation

to combine these two references would be to utilize the pay per use protection

technique for the unauthorized use of the computer software as evidenced by Michel

(Abstract).

Moreover, Michel and Lampson do not disclose user at the terminal device

agrees to update the license file and a new license file received from the accounting

server is installed independent from said access to the contents. Since, Lampson teach

certificates and licenses, Examiner cites Chiles disclosing "user at the terminal device

agrees to update the file and a new file received from the accounting server is installed"

(col. 14, lines 62-col.19, lines 19; also see Fig. 5A-5D). Chiles also discloses a new file

received from the accounting server is installed independent from said access to the

contents (col. 2, lines 42-56). In other words, Chiles discloses monitoring on a periodic

basis (user-initiated or automatic time-scheduled basis) whether the client software

should be updated based on comparison of version numbers of the most recent update

available at that site and installed at the client. If the client software requires new

update, then downloading/installing updated file and changing the version number of

client's software. This interpretation is further supported by Applicant's remarks dated

3/31/2008 regarding having a system to monitor the validity of a license having the

ability to install a new license when the old license is invalid independent of the specific

contents. The automatic update feature of Chiles is consistent with Applicant's remarks

dated 10/6/2008 (page 10) regarding determining its own license validity status and

updating the license file in the terminal device.

Thus a combination of the references teaches:

at the terminal device, when the license file is not determined to be valid and a user at
the terminal device agrees to update the license file, accesses the accounting server
based on the registration certification, notification of charging is made to the accounting
server and, after the completion of the charging, access to the contents is continued and
a new license file received from the accounting server is installed independent from said
access to the contents.

Therefore, it would have been obvious to a person having ordinary skills in the art

at the time the invention was made to modify the disclosure of Michel and Lampson to

include the disclosure of Chiles. The motivation for combining these references would

be to allow user-initiated update for the software product to take place as evidenced by

Chiles (col. 14, lines 63-67).

Response to Arguments

Applicant's arguments filed on 10/6/2008 have been fully considered but they are

not persuasive due to the following reasons:

With regard to the rejection of claims 1-15, Applicant states that the

embodiments are directed to a terminal device determining its own license validity

status, and updating the license file in the terminal device, providing a benefit of

reducing communication with the server with respect to license management."

Examiner respectfully disagrees.

Examiner notes that Lampson discloses features such as certificates and

licensing. Chiles discloses monitoring on a periodic basis (automatic) whether the client

software should be updated based on comparison of version number of the most recent

update available at that site and installed at the client. If the client software requires new update, then downloading/installing updated file and changing the version number of clients' software.

Applicant further states that Michel ...teaches away from the claimed the terminal device, when the license file is not determined to be valid and a user at the terminal device agree to update the license file. Examiner respectfully disagrees.

Examiner notes that "the prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit or otherwise discourage the solution claimed ..." (see MPEP 2141.02 VI).

Applicant further states that no evidence has been provided, expressly or implicit, that one skilled in the art would further modify Chiles software updating to extend to the claimed "terminal device..." Examiner respectfully disagrees.

Examiner refers to the motivation statement cited in the rejection as presented above on page 5.

Applicant states that Chiles discusses that a user can set a date or can manually launch a web browser to connect to a software providers FTP update site to download an update for a product. Examiner respectfully disagrees.

Examiner states that Chiles discloses automatic updating a file.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to RAJESH KHATTAR whose telephone number is

(571)272-7981. The examiner can normally be reached on Flex schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, James Kramer can be reached on 571-272-6783. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James A. Kramer/
Supervisory Patent Examiner, Art Unit 3693

/R. K./
Examiner, Art Unit 3693